

**DOCKET NO.:** MSFT-4160/37779.03

**Application No.:** 09/970,409

**Office Action Dated:** September 27, 2005

## **REMARKS**

Claims 21-35 remain in the application. Claims 23-25 and 32 stand rejected. Claims 26-31, 33, and 34 have been indicated by the Examiner as allowable. Applicants previous response to the section 1.105 requirement for information dated May 3, 2005 was deemed non-responsive by the Examiner as allegedly unclear whether the response was acknowledged by each of the Applicants, Assignee (Microsoft ®), and Applicants' representative. In addition, the phrase "about March 1996" is alleged to be not sufficiently descriptive. Applicants herein provide a supplemental response to advance the prosecution in this case.

### ***Requirement For Information -37 USC §1.105***

Applicants, Assignee, and Applicants' representative are required under 37 CFR 1.105 to provide the Examiner with information that the Examiner believes is reasonably necessary to the examination of this application. In particular, the Assignee (Microsoft®) and inventors (Applicants) and Applicant's Representative(s) are required to provide the Patent Office with information on the first use and/or offer for sale of Microsoft product using the feature "IntelliSense" and relevant documentation of operations and use with an interpreted or compiled environment. The information is required to identify the date of first use and first sale of Microsoft products with "IntelliSense" and documentation on the operations and use with an interpreted or compiled environment.

Applicants, Assignee, and Applicants' representative acknowledge the duty to comply with the requirement for information. Applicants' representative have no first hand or personal knowledge or records with respect to the first use or sale of products with "IntelliSense," VB 5.0, Visual Basic 5.0 or any other products discussed in the examiner's Action. Applicants'

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representative requested the Applicants and Assignee to provide all information available to them relevant to the Examiner's request. Based on available records, knowledge, information, and belief, Applicants and Assignee have provided the following information in response to the Examiner's request.

As an initial point of clarification, "Intellisense" was used by Microsoft in a variety of different contexts. So of those contexts were not directed to a feature also referred to as "statement completion."

- Office 4.3 was available June 3, 1994. The Office 4.3 suite contained Excel 5.0 and VBA, Word 6.0. Documentation describing the features of that product accompany this response (see reference 1 identified on the attached PTO 1449 form). The VBA release in Office 4.3 did not contain a "statement completion" feature.
- VBA 5.0 was announced on June 4, 1996 in Chicago at PC Expo. It shipped in January 1997 in Microsoft Office 97 (Word and Excel). There was a Microsoft Office 97 beta 1 and 1A release with shipments beginning on March 21, 1996. The Microsoft Office 97 beta release beginning on March 21, 1996 contained VBA 5.0. Between March 21, 1996 and May 27, 1996 approximately 283 beta testers were shipped a copy of Microsoft Office 97 beta release. After May 27 1996 until July 8, 1996 an additional 132 beta testers were shipped a copy of Microsoft Office 97 beta 1 and 1A release. That version of VBA 5.0 did contain a "statement completion" feature as indicated in the beta test user manual. After a reasonable search, Applicants, Assignee and Applicants' Representative were not able to locate a copy of the Microsoft Office 97 beta 1 or 1A release software. A copy of the beta test user manual shipped with the beta 1 and 1A releases is attached hereto (see reference 5 on the attached 1449 form). The beta testers involved in the Microsoft Office 97 beta 1 and 1A testing were required to agree to terms of a beta test license in exchange for participation in the program. The beta test license agreement required the testers to

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maintain confidentiality, prohibited the beta tester from demonstrating the product to third parties and required the beta testers to provide Microsoft with reasonable feedback.

- VBA 5.0 was available for third parties to license on June 4, 1996. Prior to that date, VBA shipped in Microsoft Office 4.3, which began shipping June 3, 1994 as noted above.
- VBA 5.0 was included in Microsoft Project sometime after the release of Office 97.
- Visual Basic 5.0 was announced February 3, 1997 . See e.g.,  
<http://www.microsoft.com/presspass/press/1997/Feb97/VB5PROpr.asp> (see reference 2 identified on the attached PTO 1449 form). That version of Visual Basic contained the following “Intellisense” features:
  - List Properties/Methods: presents a drop-down list of properties available for that control; and
  - Auto Quick Info: displays the syntax for statements and functions.

Applicants believes that the products were not marketed with the name “Intellisense” at that time of release of Visual Basic 5.0. Assignee has no records that are reasonable accessible that describe the use of the name “Intellisense” in the marketing of Visual Basic 5.0. Applicants’ Representative has no knowledge regarding the names used in marketing Visual Basic 5.0.

- Visual Basic 6.0 was announced June 15<sup>th</sup>, 1998. See e.g.,  
<http://www.microsoft.com/presspass/press/1998/Jun98/VB6ancpr.asp> (see reference 3 identified on the attached PTO 1449 form). That version of Visual Basic contained the following “Intellisense” features:
  - Auto Quick Info: see Visual Basic 5.0 above; and
  - Auto List Members: When a user enters the name of a control in his or her program code, the Auto List Members feature presents a drop-down list of properties available for that control.

These two features can be found in the online Visual Basic 6.0 documentation found here (see reference 4 identified on the attached PTO 1449 form):

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<http://msdn.microsoft.com/library/default.asp?url=/library/en-us/vbcon98/html/vbconusingcodeeditor.asp>

The Visual Basic 6.0 documentation does not refer to these features as Intellisense.

***Telephone Interview With Examiner Ingberg***

Applicants acknowledge with appreciation the time and courtesies extended by the Examiner toward Applicants' representative during a telephone interview conducted with Applicants' representative on October 25, 2005. The Examiner's insights and comments have advanced the prosecution of the case. In particular, the alleged non-responsiveness of the previous response to the section 1.105 request for information was discussed. Further discussion involved ways to move prosecution in this matter forward.

***Conclusion***

Applicants, Assignee, and Applicants representative have made a bona fide attempt to provide the Examiner with the requested information regarding Intellisense and related products. A Notice of Allowance for all pending claims is earnestly requested..

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